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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,158	04/08/2004	David B. Sutton	PRIV 0107 PUS	9192
22045	7590	11/10/2008	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3693	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/821,158	SUTTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAGDISH N. PATEL	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 September 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 15-17 and 19-27 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 15-17 and 19-27 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. This communication is in response to amendment filed 9/10/08

### *Response to Amendment*

2. Claims 15 and 26 have been amended. Claim 18 have been cancelled. Claims 15-17 and 19-27 are currently pending.

### *Response to Arguments*

3. The applicant has incorporated limitations of the claim 18 into now amended claim 1 and further clarifying that the "same cardholder name" that is different from a card purchaser's name.

#### **3.1 112 (second) rejection of claim 18 and amendment of claim 1 incorporating amended version of claim 18**

It is noted that claim 18 was originally rejected for the following two reasons:

(a) Claim 18 recited "each of the plurality of purchase cards embodies a different account number but having the same cardholder name" which contradicted with claim 15 which states that the purchase card does not identify the person who acquired the purchase card but having a same card holder name. Claim 18 was rejected as being vague and indefinite.

The amendment has corrected this ambiguity.

(b) None of the features of claim 18 have any correlation to the process recited in claim 15.

**The amendment has not addressed this part of the 112 (second) rejection.**

Accordingly, claim 1 has inherited the deficiency that the feature of claim 18 do not correlate to process of amended claim 1 because the applicant has not explained how the features of (now amended) claim 1 concerning the purchase card having a same cardholder name that is different from a card purchaser's name is relevant to the purchase transaction process steps of providing purchase transaction information and transacting a purchase with a retailer.

In this regard, the purchase card having a card holder name (same as the cardholder or different from the cardholder) is a non-functional descriptive matter since it does not alter the process of acquiring, providing or transacting steps of claim 15. Alternatively, the claimed process is performed independent of whether the cardholder name is same as the purchaser or different. (See following explanation for legal basis).

Since we are examining applications for utility patents, the claims must be directed to systems, methods or articles of manufacture that have a clear utility. See MPEP 706.03(a) for example. Over the years, numerous court decisions have analyzed the content of various claim language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decisions have found that certain language adds little, if anything, to the claimed structure or acts and thus do not serve as a limitation on the claims to distinguish over the prior art.

Thus, a limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), Ex

parte Carver, 227 USPQ 465 (BdPatApp&Int 1985) and In re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Since the content of the card other than the account number does not functionally interrelate to the claimed process, the card holder name does not constitute a limitation and therefore not considered for patentability.

Claim 26 has been amended in an analogous manner to incorporate the feature of the purchase card being selected from a plurality of purchase cards wherein each card has a different account number but having a same cardholder name that is different from a card purchaser's name.

As explained in the foregoing discussion, this limitation does not render the claim allowable over Risafi because the newly added limitation language is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation.

### **3.2 102 rejection over Risafi**

The applicant has not provided any explanation of how newly amended claim overcomes Risafi as prior art, instead relying on the fact that claim 18 was not rejected over Risafi under 35 USC 102(e) due to lack of clarity as annunciated in 112(second) rejection of claim 18. The applicant has now amended claim 1 by incorporating amended version of claim 18. However, there is no explanation provided how the amended claim 1 overcomes 102(e) rejection over Risafi.

**3.3 103 Rejection of claims over Risafi and Official Notice**

The applicant has not provide any specific remarks/arguments in regard to claims 20,21,23,24 and 26-27, stating that claim 18 limitation is also incorporated in these limitations. The examiner respectfully points out that dependent claims 20, 21, 23, 24 inherit limitation of amended claim 15. Therefore, same rationale as claim 15 also applies to these dependent claims.

Claims 26 and 27 have not been amended. No specific remarks or arguments have been presented regarding these claim rejection under 103(a) over Risafi and the Official Notice. It is understood that the applicant meant to traverse the rejection under same remarks as claim 15.

The examiner respectfully points out that same response stated above concerning claim 15 also applies to claims 26 and 27.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-17 and 19-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is rendered unclear because the feature of purchase card having a same cardholder name that is different form the a card purchaser's name does not functionally relate to any process of claim 15. For example, the process of acquiring purchase card, providing purchase transaction information, transacting purchase are not affected by the purchaser's name.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 15-17, 19, 22 and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Risafi et al (US Pat. 6473500) (hereafter Risafi).

8. As per claim 15 Risafi teaches a method of transacting a purchase which comprises acquiring a purchase card from a provider (see col. 3 L 53-60). Such card is a bearer instrument having an account number (Fig. 3a 306), but does not identify the person who acquired the card.

Risafi further teaches transacting a purchase with a retailer based on the account number associated the purchase card after purchase transactional information including the account number is provided to a retailer who is not the card provider (see Fig. 6a and relevant description of purchase at a merchant).

As per claims 16 and 17 the purchase card has indicia of a card issuer (310 and 304).

Risafi is silent about each purchase card having a same cardholder name that is different from a card purchaser's name. However, the purchase card of Risafi furthermore does not have an indicia of an interchange association and indicia of other entity associated with distribution of the card.

However, this data on the purchase card does not contribute the functionality of the claimed process and hence treated as non-functional descriptive material. Accordingly, no patentable weight is given to these non-functional descriptive. It has been ruled by the courts that non-functional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983), *In re Ngai* 367 F.3d 1336, 1339, 70USPQ2d 1862, 1864 (Fed. Cir. 2004). (See also detailed explanation under “Response to Arguments” above).

The examiner also respectfully submits that this analysis is consistent with the USPTO policy as affirmed by the Board of Patent Appeals and Interferences (BPAI) (See Ex Parte Herman Mathias, Appeal No. 2005-1851 available at link <http://www.uspto.gov/web/offices/dcom/bpai/its/fd051851.pdf>)

which states that a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention cannot lend patentability to an invention that would have been anticipated by prior art.

As per claim 19 Risafi teaches a step of acquiring a purchase card further comprises purchasing the purchase card from a retail establishment, where the purchase card is provided to the retail establishment by the purchase card provider. (Col. 3 L 55 - col. 4 L 16).

As per claim 22, Risafi teaches a step activating the purchase card (see col. 3 L 61-65).

As per claim 25, Risafi teaches a step of transacting a purchase with the retailer by way of an authorization system of an interchange association (any authorization of card is carried out over a payment network. such step is therefore, inherent in Risafi, see Fig. 6a)

- . All limitations of claims 26 and 27 have been analyzed under claim 15 rejection.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 20, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi as applied to claim 19 above, and further in view of Official Notice.

Various feature recited in claims 20-23 such as consignment arrangement and service fee charges are old and well known practices in commerce and the examiner takes official notice of these facts.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement these features in order to provide incentives to the card distributors so as to participate in the card distribution process. Providing contact information is also old and well known feature and is provided to facilitate communication with the card issuer regarding account balances etc.

***Conclusion***

12. . . . . Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KRAMER JAMES A can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/  
Primary Examiner, Art Unit 3693